

REMARKS

The “Conclusion” section on page 9 of the Office Action dated July 23, 2004 characterizes that action as final, in violation of accepted Patent Office standards, MPEP 706.07(a) (“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in **37 CFR 1.97(c)** with the fee set forth in **37 CFR 1.17(p)**), and the finality of the current Office Action cannot be sustained.

Although the Office Action alleges on page 9 that “Applicant’s amendment necessitated the new ground(s) of rejection,” the applicants’ May 3, 2004 amendment in response to the previous Office Action merely:

- a) redrafted claim 6 into independent form as claim 1;
- b) redrafted claims 10 and 17 into independent form, with a minor grammatical correction in claim 10 of replacing “said” with “the”;
- c) updated respective claim dependencies in claims 7, 11 and 18; and
- d) re-instated claims 3 and 15, which were rejected based on prior art earlier in the prosecution.

The new grounds for rejecting claim 1 (former claim 6), for example, were based on a newly-found reference, and were not necessitated by the applicant’s amendment.

Instead, the new grounds for rejection of claim 1 were necessitated by the

persuasiveness of the applicant's argument.

Reconsideration and withdrawal of the finality of the current Office Action is respectfully requested, to avoid the need for the applicants to take further measures within the Patent Office.

The Office Action mailed July 23, 2004 has been reviewed and carefully considered. The subject matter of original claim 3 has been revised, and claim 3 has been re-numbered as new claim 26 and canceled. The subject matter of claim 15 has been incorporated into independent claim 14, and claim 15 has been canceled. Claim 18 has been canceled. Claims 1, 2, 4, 7, 8, 11-16, 25 and 26 are pending, of which the independent claims remain 1, 8 and 14. Claim 8 has been amended. Reconsideration of the above-identified application, as amended and in view of the following remarks, is respectfully requested.

Former claims 3 and 15 stand objected to as annotated under 37 CFR 1.121, subsection 5. Claim 3 has now been added, with revision, as new claim 26 as recommended by the Examiner. Claim 15 has been redrafted into independent form, with revision, as claim 14.

The last sentence on page 2 of the Office Action rejects claims 26 and 14 based on the anticipation rejection in the August 22, 2003 Office Action.

Claim 26, as amended, recites "wherein the host computer, prior to the creation of the file for production, attaches a storage address of the flash memory, a compression state, and a booting state for the production file," a limitation that Nelson fails to disclose or suggest.

Nelson discloses "Record type" and "Checksum" fields, but does not

disclose or suggest the attaching of “a compression state, and a booting state for the production file” as explicitly required by the language of claim 26. Accordingly, for at least this reason, Nelson fails to anticipate the invention as recited in claim 26.

Claim 14, as amended, recites the same language and is likewise deemed to be patentable over Nelson for at least the same reasons set forth above with regard to claim 26. As will be set forth below, the current basis for rejection of claim 14, based on a new reference in view of Nelson, cannot be sustained.

Claims 1-4 and 7 stand rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,603,056 to Totani in view of U.S. Patent No. 6,526,092 to Nelson et al. (“Nelson”).

Claim 1 recites, “an apparatus comprising: a host computer . . .; a flash memory . . .; a personal computer . . .; and a DRAM . . .”

Totani, firstly, fails to disclose or suggest a personal computer (PC). The Totani user (col. 5, line 14: “operator”) uses the Totani host computer 7. The latter is not disclosed to be a PC, but, even if the Totani host 7 were a PC, there is no disclosure or suggestion of an embodiment in which “the PC stores the production file in the flash memory” which language explicitly appears in claim 1.

Even if the Totani microcomputer 1 were to be deemed a PC, that “PC” includes the RAM 3. Accordingly, it is unclear how Totani can fairly be said to disclose or suggest an apparatus comprising both a PC and a DRAM.

Page 3 of the Office Action suggests that the Totani CPU 2 is the “PC.” The applicant believes, however, that such a position is untenable and could not be sustained.

Nor does Nelson seem to be of any help in curing this deficiency in Totani. For at least the foregoing reasons, the proposed combination of prior art fails to render obvious the invention as recited in claim 1.

Additionally, even if we were to entertain the notion of the Totani CPU 2 constituting a personal computer, claim 1 recites, "the PC stores the production file in the flash memory using the production-processing program in the flash memory."

The Office Action suggests on page 3 that the production file of the present invention is the Totani control program, and that the production-processing program of the present invention is the Totani rewrite program.

Even if these correspondences were deemed to be valid, the Totani rewrite program in flash memory 5 is not used in storing a control program into the flash memory (col. 6, lines 21-23; col. 5, lines 33-34, 65-67).

Instead, the Totani rewrite program in RAM 3 is used, because the rewrite program in flash memory 5 cannot (col. 6, line 22: "cannot") be used. This is a fundamental principle upon which Totani bases its methodology.

Totani, accordingly and for at least this reason, fails to disclose or suggest, "the PC stores the production file in the flash memory using the production-processing program in the flash memory" which limitation explicitly appears in claim 1.

Nor can Nelson compensate for this deficiency in Totani, at least because such would involve changing the principle upon which the primary reference operates. Such a modification is deemed to be non-obvious, MPEP 2143.01, even if the re-design were realizable and regardless of whether any suggestion of such modification could be

found in the secondary reference(s). For these reasons too, the proposed combination of prior art fails to render obvious the invention as recited in claim 1 of the present invention.

Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 8, 11-13 and 25 stand rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,209,127 to Mori et al. (“Mori”) in view of Nelson.

Claim 8, as amended, recites:

said personal computer is further operable for transmitting to the firmware board said updated firmware downloaded from said host computer and wherein, based on an analysis of the transmitted firmware by a production-processing program in said first memory means, the production-processing program operates in either the first or second memory means in storing the transmitted firmware into a corresponding region of said first memory means

Neither Mori nor Nelson disclose or suggest, alone or in combination, the above limitation of claim 8 as amended. Support for the amendment of claim 8 is found in the specification (e.g., page 13, line 17 to page 14, line 8).

Claims 14-16 and 18 stand rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,615,404 to Garfunkel et al. in view of Nelson.

Claim 14, as amended, recites, “the production file includes a header portion containing a storage address of the flash memory, a compression state, and a booting state for the production file.”

The Office Action cites to passages in Nelson for this disclosure, but, as set forth above with regard to claim 26, the above-quoted limitation is neither disclosed nor suggested by Nelson. Neither reference, alone or in combination, discloses or suggests this limitation.

For the remaining rejected claims, each depends from a base claim and is deemed to be patentable for at least the same reason(s).

In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. The Examiner is invited to contact the undersigned in the event of any perceived outstanding issues so that passage of the case to issue can be effected without the need for a further Office Action.

In the event that any additional fee is required to continue the prosecution of this Application as requested, please charge such fee to Deposit Account No. 502-470.

Respectfully submitted,

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